

REMARKS

In the Office Action mailed August 26, 2006 from the United States Patent and Trademark Office, the Examiner rejected claims 1, 4, 5, 8, 10, 29, 33, 35-38, and 46-48 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,385,675 to Yamaguchi (hereinafter “Yamaguchi”). The Examiner also rejected claims 7 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Yamaguchi in view of U.S. Patent No. 6,618,566 to Kurijai et al. (hereinafter “Kurijai”), rejected claims 11-13 and 39-41 under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi in view of Applicant’s specification, and rejected claims 14, 16, 18, 21, and 42-45 under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi in view of U.S. Patent No. 5,602,974 to Shaw, (hereinafter “Shaw”). Accordingly, Applicant respectfully provides the following:

The standard for a Section 103 rejection is set for in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Applicant respectfully submits that the references cited by the Examiner, alone or in combination, do not teach or suggest the limitations claimed in the present invention. Furthermore, Applicants respectfully submit that there is no motivation to combine references in the manner suggested by the Examiner found in the references themselves, but that any proposed motivation is based on impermissible hindsight reasoning using Applicant’s disclosure.

Section 103 specifically requires assessment of the invention “as a whole.” The Federal Circuit explained that inventions typically are new combinations of existing principles or features. *Envil. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that “virtually all [inventions] are combinations of old elements”). The “as a whole” instruction in title 35 prevents evaluation of the invention part by part. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004). The Federal Circuit further explained that

[w]ithout this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. [*Ruiz* at 1275.] This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result - often the essence of invention. *Id.*

Contrary to this reasoning, section 103 requires assessment of the invention as a whole. *Id.* This “as a whole” assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. *Id.* In other words, section 103 requires some suggestion or motivation, before the invention itself, to make the new combination. See *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

*Princeton Biochemicals Inc. v. Beckman Coulter Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005).

Any such suggestion must be “found in the prior art, and not based on applicant’s disclosure.” *In re Vaeck*, 947 F.2d at 493. Indeed, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). A “clear and particular” showing of the suggestion to combine is required to support an obviousness rejection under Section 103. M.P.E.P. § 2142.

In the Office Action, the Examiner suggested that Yamaguchi teaches the claimed limitation of “using the print subsystem component to determine an amount of available funds in

the user's account." Applicant respectfully disagrees. The passage cited by the Examiner, column 4 lines 45-48 states, "The image processor 101 also carries out to an accounting operation and calculates an estimated charge. Then the image processor 101 transmits the estimated charge to respective host computer 102." (Col 4 lines 45-48, emphasis added) This passage deals with calculating an estimated charge (i.e. a bill) and transmitting it to a printing host computer, not with calculating or determining an amount of available funds in the user's account, as is clearly required by the claim.

Claim 1 additionally requires "if the amount of available funds exceeds the cost for consumables, using the print subsystem component to debit the cost of the print job from the user's account." Contrary to the position taken by the Examiner, Applicant respectfully submits that this is not taught by Yamaguchi. First, as discussed above, Yamaguchi never makes a determination of the available funds in the user's account. Therefore, the system of Yamaguchi is not able to make a determination as claimed in claim 1 whether the amount of available funds exceeds the calculated cost for consumables. Furthermore, the system of Yamaguchi does not describe any ability to actually debit the cost of the print job from a user's account. Instead, the system described by Yamaguchi is limited to merely providing a charge or bill to the user, who presumably must settle that bill externally to any print system or component. (Col 2 line 67-Col 3 line 3 (Account of use prepared, and account notice sent to the host computer.), Col 4 lines 33-51 (An estimated charge is provided so that the user can change functions to reduce the charge, but no debit of the account actually occurs.) Indeed, the passage particularly relied on by the Examiner, column 4 lines 64-67 merely indicates that an upper limit on the amount to be charged may be set with notice given if the charge amount exceeds this limit, but again no actual debiting occurs. That the accounting provided is merely a charge or bill and not a debit of a user's

account may be clearly appreciated by reference to column 3 lines 4-8: “The account notice may be sent to the appropriate host computer 102 along with each copying job, or periodically, such as monthly, or when the total charge exceeds a predetermined amount, or as requested by the user.”

Therefore, for at least these reasons, Applicant respectfully submits that Yamaguchi fails to teach or suggest every limitation of independent claim 1. Applicant therefore respectfully submits that independent claim 1 is not made obvious by the cited reference. Independent claim 29 contains similar limitations, and is allowable for at least the same reasons. All other pending claims depend from either claim 1 or claim 29, and are therefore similarly allowable for at least the above reasons. Applicant therefore respectfully requests the withdrawal of all rejections under 35 U.S.C. § 103(a).

Additionally, regarding claims 11-13 and 39-41, the Examiner rejected these claims as being unpatentable over Yamaguchi in view of Applicant’s own disclosure in the specification regarding specific methods of determining the number of pages in a print job. The Examiner then indicated that the motivation to combine Applicant’s disclosure with Yamaguchi “would have been to use the EMF pathnames to easily identify parts of a print job for easier job accounting.” In doing so, the Examiner did not indicate a source for this motivation, thus failing the requirements of Section 103, as set forth above. Applicant respectfully submits that in doing so the Examiner must have improperly used Applicant’s own disclosure instead of relying on a motivation drawn from the cited references themselves, thus using impermissible hindsight reasoning. Yamaguchi never discloses any mechanism for counting pages, nor does it discuss in any way “easily identifying parts of a print job for easier job accounting.” Thus, Applicant respectfully submits that the only potential source for such a motivation must have been the

impermissible one of Applicant's own disclosure. Applicant therefore respectfully requests removal of any rejection relying on Applicant's own disclosure.

Regarding the rejections of claims 7 and 34 based on the proposed combination of Yamaguchi and Kurijai, Applicant again respectfully notes that the Examiner has proposed a combination and provided an unsupported "motivation" to combine the references. Applicant has searched the Kurijain and Yamaguchi references, and nothing in either reference suggests that embedding authentication information somehow "makes it easier to keep track of jobs." Thus, Applicant respectfully submits that the proposed motivation to combine is not found in the cited references themselves, but is further evidence of impermissible hindsight reasoning. When taken with the fact that the cited references fail to disclose all claim limitations, as discussed above, it is clear that the rejections should be removed, and Applicant respectfully requests such action.

Regarding the rejections of claims 14, 16, 18, 21, and 42-45, Applicant again notes that the Examiner has made an unsupported assertion of a motivation to combine references. This is contrary to the Patent Office's own mandate that a "clear and particular" showing of the motivation to combine references is required to maintain a rejection under 35 U.S.C. § 103. M.P.E.P. § 2142. Again, Applicant fails to understand how one of skill in the art, without the hindsight provided by Applicant's own disclosure, would be motivated to combine references in the manner suggested by the Examiner to arrive at the claimed invention. Applicant therefore respectfully requests removal of the rejections.

Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein overcomes all rejections made by the Examiner in the Office Action.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 20 day of November, 2006.

Respectfully submitted,

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